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EXAMINER

MAYO III, WILLIAM H

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/075,786
Filing Date: February 13, 2002
Appellant(s): HOLLAND ET AL.

MAILED
SEP 18 2006
GROUP 2800

Lewis S. Rowell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 28, 2006 appealing from the
Office action mailed November 30, 2005

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

This case was assigned Appeal Number 2005-0288, on November 29, 2004 and is directly related to co-pending application Serial Number 09/860,423, assigned Appeal Number 2005-0117, on November 2, 2004, both cases of which were affirmed March 29, 2005.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,300,337	ANDRIEU et al	04-1994
5,395,682	HOLLAND et al	5,395,682
4,891,256	KITE, III et al	01-1990
5,070,597	HOLT et al	12-1991
5,441,790	RATIGAN	08-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1) Claims 1-9 and 27-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrieu (Pat Num 5,300,337) in view of Holland et al (Pat Num 5,395,682, herein referred to as Holland). Andrieu discloses a protective cover (Figs 1-4) for cables or hoses (abstract), which are capable of being used in environments wherein the cover (Figs 1-4) may be subject to abrasion and weather extremes (i.e. heat, Col 1, lines 12-20). Specifically, with respect to claim 1, Andrieu discloses a protective cover (10) comprising a sleeve (Figs 1-2, Col 3, lines 55-59) capable of surrounding a cable or hose (abstract, Fig 4), wherein the sleeve has open ends (left and right ends) and is formed of a fabric (10) made of substantially high strength yarn (11, i.e. polyester, Col 3, lines 8-12). With respect to claim 2, Andrieu discloses that the fabric (11) is formed from at least 70 percent high strength yarns (i.e. 100 % polyester). With respect to claim 6, Andrieu discloses that the high strength yarn (11, i.e. polyester) is about 400 to 1000 denier (i.e. 600-2500, Col 3, lines 60-67). With respect to claim 7, Andrieu discloses that the fabric covering (10) has a warp and fill density of about 40 ends per

inch (Col 4, lines 1-10). With respect to claim 8, Andrieu discloses that the sleeve (Fig 1) is formed as an elongated sheet having opposing longitudinal edges (top and bottom edges), wherein the opposed longitudinal edges (top and bottom edges) includes means (15) for releasably attaching the opposed longitudinally edges together (Col 4, lines 24-31) around the length of a cable or hose (abstract, Fig 4). With respect to claim 9, Andrieu discloses that the means (15) for fastening the longitudinal edges comprises hook and loop material (see 15, Col 4, lines 35-47). With respect to claim 27, Andrieu discloses an abrasion resistant cable system (Fig 4) comprising a cable (not numbered) that is subject to being periodically moved across abrasion surfaces (Col 1, lines 12-20) and a protective sleeve (10) surrounding the cable, which is formed from a fabric made of substantially high performance yarn (i.e. polyester), has open ends (left and right ends), and protects the cable (Fig 4) from abrasion and wear thereof (Col 1, lines 12-20). With respect to claim 28, Andrieu discloses that the fabric (11) is formed from at least 70 percent high strength yarns (i.e. 100 % polyester). With respect to claim 32, Andrieu discloses that the high strength yarn (11, i.e. polyester) is about 400 to 1000 denier (i.e. 600-2500, Col 3, lines 60-67). With respect to claim 33, Andrieu discloses that the fabric covering (10) has a warp and fill density of about 40 ends per inch (Col 4, lines 1-10). With respect to claim 34, Andrieu discloses that the sleeve (Fig 1) is formed as an elongated sheet having opposing longitudinal edges (top and bottom edges), wherein the opposed longitudinal edges (top and bottom edges) includes means (15) for releasably attaching the opposed longitudinally edges together (Col 4, lines 24-31) around the length of a cable or hose (abstract, Fig 4). With respect to claim 35, Andrieu

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discloses that the means (15) for fastening the longitudinal edges comprises hook and loop material (see 15, Col 4, lines 35-47).

However, Andrieu doesn't necessarily disclose the protective cover being made of a high performance yarns having a tensile modulus equal to or greater than 150g/denier and a tenacity equal to or greater than 7 grams/denier, wherein the yarns are cut and tear resistant (claims 1 & 27), nor the protective cover being made of a material fabric having a weight of between of between about 5 & 8 ounces per square yard (claims 3 & 29), nor the fabric being resistant to petroleum based products (claims 4 & 30), nor the high strength yarn being selected from the group consisting of long chain polyethylenes, high strength aramids, liquid crystal polymers, and combinations thereof (claims 5 & 31), nor the fabric density of between about 30 and 36 inches per inch (claims 7 & 33).

Holland teaches a protective cover, that is made of Spectra® fibers (Col 2, lines 28-37), that overcomes the disadvantages of polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment (Col 1, lines 5-10). Specifically, with respect to claim 1, Holland teaches that the protective cover is made of high performance yarns, such as Spectra® fibers that inherently has a tensile modulus equal to or greater than 150g/denier and a tenacity equal to or greater than 7 grams/denier. With respect to claim 3, Holland teaches that the fibers may be used to form a fabric having a weight of between about 5 & 8 ounces per square yard (Col 2, lines 49-51) for the purpose of providing a fabric that is lightweight while also providing a sufficient

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strength and durability to withstand the use and environment to the fabric is exposed (Col 2, lines 51-56). With respect to claim 4, Holland teaches that the fabric formed of Spectra® fibers are chemical resistance to petroleum-based products (Col 4, lines 45-51). With respect to claim 5, Holland teaches that the fabric containing Spectra® fibers, which are long chain extended polyethylene (Col 2, lines 25-30). With respect to claims 7, Holland teaches that the fabric may be constructed to have a warp and fill density of between 30 and 36 ends per inch (Col 2, lines 49-51). With respect to claim 27, Holland teaches that the protective cover is made of high performance yarns, such as Spectra® fibers that inherently has a tensile modulus equal to or greater than 150g/denier and a tenacity equal to or greater than 7 grams/denier. With respect to claim 29, Holland teaches that the fibers may be used to form a fabric having a weight of between about 5 & 8 ounces per square yard (Col 2, lines 49-51) for the purpose of providing a fabric that is lightweight while also providing a sufficient strength and durability to withstand the use and environment to the fabric is exposed (Col 2, lines 51-56). With respect to claim 30, Holland teaches that the fabric formed of Spectra® fibers are chemical resistance to petroleum-based products (Col 4, lines 45-51). With respect to claim 31, Holland teaches that the fabric containing Spectra® fibers, which are long chain extended polyethylene (Col 2, lines 25-30). With respect to claim 33, Holland teaches that the fabric may be constructed to have a warp and fill density of between 30 and 36 ends per inch (Col 2, lines 49-51).

With respect to claims 1-9 and 27-35, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the

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protective cover, which is made of polyester fibers, of Andrieu to comprise the Spectra® fibers and the fabric parameters of the protective fabric as taught by Holland because Holland teaches that such a fabric by made of commercially available Spectra® fibers and having the specified parameters, overcomes the disadvantages of polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment in which the cover is used (Col 1, lines 5-10) and since it has been held to be within general skill of a worker in the art to select a commercially available or known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

2) Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ratigan (Pat Num 5,441,790) in view of Holland et al (Pat Num 5,395,682). Ratigan discloses a protective cover (1) for use with a rope (Figs 1-4), and which is used in environments in which lengths of the rope are subject to abrasion (Col 1, lines 5-10). Specifically, with respect to claim 40, Ratigan discloses an abrasion resistant rope (5) of the type that is capable of periodically moved across abrasive surfaces (Col 1, lines 62-68) comprising a sleeve (Fig 1) surrounding a length of a rope (5), wherein the sleeve (Fig 1) is formed of a fabric (i.e. textile material) made of substantially high strength yarn (i.e. polyester fibers, Col 2, lines 1-3).

However, Ratigan doesn't necessarily disclose the protective cover being made of a high performance yarns having a tensile modulus equal to or greater than

150g/denier and a tenacity equal to or greater than 7 grams/denier, wherein the sleeve is cut resistant or cut resistant (claim 40).

Holland teaches a protective cover, that is made of Spectra® fibers (Col 2, lines 28-37), that overcomes the disadvantages of polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment (Col 1, lines 5-10). Specifically, with respect to claim 40, Holland teaches that the protective cover is made of high performance yarns, such as Spectra® fibers that inherently has a tensile modulus equal to or greater than 150g/denier and a tenacity equal to or greater than 7 grams/denier.

With respect to claim 40, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the protective cover, which is made of polyester fibers, of Andrieu to comprise the Spectra® fibers and the fabric parameters of the protective fabric as taught by Holland because Holland teaches that such a fabric by made of commercially available Spectra® fibers and having the specified parameters, overcomes the disadvantages of polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment in which the cover is used (Col 1, lines 5-10) and since it has been held to be within general skill of a worker in the art to select a commercially available or known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

3) Claims 10-12 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrieu (Pat Num 5,300,337) in view of Holland et al (Pat Num

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5,395,682, herein referred to as modified Andrieu), as applied to claims 1 and 27 above, further in view of Kite, III et al (Pat Num 4,891,256, herein referred to as Kite).

Modified Andrieu discloses a protective cover (Figs 1-4) for cables or hoses (abstract), which are capable of being used in environments wherein the cover (Figs 1-4) may be subject to abrasion and weather extremes (i.e. heat, Col 1, lines 12-20) as described above. Specifically, with respect to claim 10, modified Andrieu discloses a protective cover (10) comprising a sleeve (Figs 1-2, Col 3, lines 55-59) capable of surrounding a cable or hose (abstract, Fig 4). With respect to claim 11, modified Andrieu discloses that the sleeve (Fig 1) is formed having opposing longitudinal edges (top and bottom edges), wherein the opposed longitudinal edges (top and bottom edges) includes means (15) for releasably attaching the opposed longitudinally edges together (Col 4, lines 24-31) around the length of a cable or hose (abstract, Fig 4). With respect to claim 12, modified Andrieu discloses that the means (15) for fastening the longitudinal edges comprises hook and loop material (see 15, Col 4, lines 35-47). With respect to claim 36, modified Andrieu discloses a protective cover (10) comprising a sleeve (Figs 1-2, Col 3, lines 55-59) capable of surrounding a cable or hose (abstract, Fig 4). With respect to claim 37, modified Andrieu discloses that the sleeve (Fig 1) is formed having opposing longitudinal edges (top and bottom edges), wherein the opposed longitudinal edges (top and bottom edges) includes means (15) for releasably attaching the opposed longitudinally edges together (Col 4, lines 24-31) around the length of a cable or hose (abstract, Fig 4). With respect to claim 38, modified Andrieu discloses that the

means (15) for fastening the longitudinal edges comprises hook and loop material (see 15, Col 4, lines 35-47).

However, modified Andrieu doesn't necessarily disclose the sleeve being a plurality of bands comprising a short length of the fabric and being spaced apart along the length of the cable or hose (claims 10 & 36), nor each band having opposed longitudinally edges including means for fastening the opposed longitudinally edges together around the length of the cable (claims 11 & 37).

Kite teaches a wraparound closure device (Figs 1-4) made of a fabric that protects elongated substrates, such as cables, from abrasion (Col 1, lines 5-10). Specifically, with respect to claims 10 & 36, Kite teaches a wraparound sleeve (10-Fig 3) that may be made of polyester (Col 4, line 49-50) and is formed as a plurality of bands (see three fabric sleeves not numbered) wherein each band comprises a short length of the fabric which are spaced apart along the length of the cable (Fig 3) for the purpose of providing effective bundling device that accommodates multiple cable break-outs (Col 1, lines 38-45). With respect to claims 11 & 37, Kite teaches that each short length of fabric (see 3 section of fabric, Fig 3) having opposed longitudinally edges (left and right sides of all three fabrics) wherein the opposed longitudinally edges has means (24, 30, & 32) for fastening the opposed longitudinally edges together around a length of the cable (Fig 3).

With respect to claims 10-11 & 36-37, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the polyester protective cover of modified Andrieu to comprise a multiple protective covers

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as taught by the Kite because Kite teaches that such a fabric configuration protects elongated articles from abrasion (Col 4, lines 5-8) and provides effective bundling device that accommodates multiple cable break-outs (Col 1, lines 38-45) and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. (*St. Regis Paper Co v. Bemis Co.*, 193 USPQ 8).

4) Claims 13 & 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Andrieu (Pat Num 5,300,337) in view of Holland et al (Pat Num 5,395,682, herein referred to as modified Andrieu), as applied to claims 1 and 27 above, further in view of Holt et al (Pat Num 5,070,597, herein referred to as Holt). Modified Andrieu discloses a protective cover (Figs 1-4) for cables or hoses (abstract), which are capable of being used in environments wherein the cover (Figs 1-4) may be subject to abrasion and weather extremes (i.e. heat, Col 1, lines 12-20) as detailed above with reference to claims 1 & 27.

However, modified Andrieu doesn't necessarily disclose the protective cover further comprising a hood made of the same fabric and fastened to at least one end of the sleeve for protecting the exposed end of the cable or hose (claims 13 & 39).

Holt teaches a double wall protective cover (Figs 1-19b) comprising flame retardant, abrasion resistance, and split or tear resistance (Col 18, lines 21-26), for the purpose of providing environmental protection, including electrical protection, and joining or mechanical holding of substrates such as cables or pipes (Col 1, lines 17-21). Specifically, with respect to claims 13 & 39, Holt discloses that the protective cover (Figs 1-19b) may be formed of polyester (Col 7, line 36) and as a hood (i.e. end cap, 19,

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Figs 6a-d), wherein the hood (19) may be fastened to at least one end of the cable or pipe (22) for protecting the exposed end of the cable or pipe (22, Col 29, lines 23-24).

With respect to claims 13 & 39, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the cable or pipe assembly of modified Andrieu to comprise a end cap protective cover formed of fabric as taught by the Holt because Holt teaches that fabrics, having excellent flame retardant, abrasion resistance, and split or tear resistance (Col 18, lines 21-26), are commonly used to protect cables and pipes are sometimes formed as end cap cover configuration that provides environmental protection, including electrical protection for the joining or mechanical holding of substrates such as cables or pipes (Col 1, lines 17-21) and also provides protection for the exposed ends of cables or pipes (Col 29, lines 23-24).

(10) Response to Argument

Specifically, the Appellant's arguments filed July 28, 2006 have been fully considered but they are not persuasive. The appellant argues:

- A) The declaration states that the claimed invention cannot be obvious because there exist a long felt but unsolved need.
- B) The declaration states that the claim invention cannot be obvious to one of ordinary skill in the art because of failure of others to invent the claimed invention.

- C) The declaration states that the claim invention cannot be obvious to one of ordinary skill in the art because the claimed invention has unexpected results.
- D) The declaration states that the claim invention cannot be obvious to one of ordinary skill in the art because of the claimed invention's commercial success

Firstly, it must be stated that the examiner clearly recognizes that the record has to be considered as a whole with respect to the declaration submitted. Specifically, Section 716.01(d) specifically cites:

716.01(d) [R-2] Weighing Objective Evidence

IN MAKING A FINAL DETERMINATION OF PATENTABILITY,
EVIDENCE SUPPORTING PATENTABILITY MUST BE WEIGHED
AGAINST EVIDENCE SUPPORTING PRIMA FACIE CASE

When an applicant >timely< submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

However, the appellant is reminded that a submission of a declaration doesn't necessarily mandate the conclusion of patentability. Specifically, the MPEP clearly states:

The submission of objective evidence of patentability does not mandate a

conclusion of patentability in and of itself. In re Chupp, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987).

Given the guidelines being set forth, with respect to arguments A & B, the examiner respectfully transverses. The appellant has supplied in the declaration that provides exhibits and letters submitted by Top Gear (Sails Magazine-exhibit A), Samson Rope Technologies (exhibit B), Mr. Dan Nathan (Titan Maritime, LLC-exhibit C), and Mike Ring (McAllister Towing -exhibit D), which the appellant feels is evidence of a long felt need and failure of others (see Pages 10-11 of Appeal Brief). Top Gear states that "The chafing gear product notes the chafing gear product as being one of the "best new products." Samson Rope states "This new product line made of patented materials offers significant advantages over other chafe gear materials currently on the market in terms of extending the durability of high performance ropes. Titan Maritime states "Nothing compares to the integrity of your product." McAllister Towing states "The best piece of chafe gear I've seen in 30 years of business." These exhibits filed May 27, 2005 and May 30, 2006 are insufficient to overcome the rejection of claims 1-27, based upon 35 USC 103(a) as set forth in the last Office action because: They include statements which amount to an affirmation that the affiant has never seen the claimed subject matter before and that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. Specifically, they essentially state that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled

in the art who were presumably working on the problem knew of the teachings of the above cited references, such as Holland, they would still be unable to solve the problem. See MPEP § 716.04.

In order to establish long felt but unsolved need, the appellant is required to submit objective evidence that an art recognized problem existed in the art for a long period of time without solution. Specifically, the relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors. The MPEP states:

First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) (“Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who unsuccessfully attempted to solve a problem of which they were not aware.”); *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the desirable result of reducing inventories, there was no evidence of any prior unsuccessful attempts to do so.).

Second, the long-felt need must not have been satisfied by another before the invention by applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) (Although at one time there was a long-felt need for a “do-it-yourself” window shade material, which was adjustable without the use of tools, a prior art product fulfilled the need by using a scored plastic material, which could be torn. “[O]nce another supplied the key element, there was no long-felt need or, indeed, a

problem to be solved".) Third, the invention must in fact satisfy the long-felt need. In re Cavanagh, 436 F.2d 491, 168 USPQ 466 (CCPA 1971).

Given the guidelines above, the examiner states the following: (1) Although the claimed invention achieved the desirable result of providing superior abrasion resistance, cut resistance, etc, there was no evidence of any prior unsuccessful attempts to do so. Secondly, Holland (Pat Num 5,395,682, herein referred to as Holland) clearly teaches a protective cover that is that is made of Spectra® fibers (Col 2, lines 28-37), that overcomes the disadvantages of prior art polyester fabric covers (Col 2, lines 16-23), has minimal weight, increased abrasion resistance, tear strength, cut and stab resistance, and is compatible with the environment (Col 1, lines 5-10). While the appellant states that Holland is geared toward a cargo cover, Holland clearly teaches that the protective cover can also be utilized in other applications, where the protection of interior components by a cover having the properties of abrasion and weather resistance is needed (see Col 3, lines 18-24). Holland also states in Column 2, lines 25-34, that the source of fibers is sold by Allied Signal under the trademark Spectra® within the scope of Patent Number 4,413,110 (herein referred to as '110). A brief examination of the '110 patent states that the Spectra® material, exhibiting high tenacity, modulus, and toughness, may be utilized in various applications such as marine ropes and cables, such as mooring lines used to secure supertankers to loading stations and the cables used to secure deep sea drilling platforms to underwater anchorage instead of materials such as polyester (see '110 patent, Cols 2-3, lines 58-68 & 1-19 respectively). The '110 patent was granted in November of 1983, almost twenty-three years ago. A brief text search of the internet reveals that Spectra®, now owned

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by Honeywell, has been around for two decades and has been utilized in various applications, such as bullet proof vest, towing, dental floss, and cabling and is part of the specialty materials unit, totaling sales of 777 million in this year's first quarter because of the strength and light weight of the modified polyethylene (ie Spectra®). Clearly, the second aspect of establishing the long felt need criteria cited above has not been met since another supplied the key element, and there was no long felt need or, indeed, a problem to be solved. The Holland reference clearly teaches utilizing the known material Spectra as a protective cover for the exact purpose (i.e. superior abrasion resistant, cut resistant, etc) as the appellant states in the specification (see Page 2 of appellant's specification), prior to the filing of appellant's application. In view of the above statements, it is submitted that the declaration is insufficient to establish a long felt but unsolved need. Based on the above statements, there isn't any factual evidence the claimed invention satisfies a long felt need, because in order to satisfy a long felt need, because the long felt need must not have been satisfied by another before the invention by the appellant. *Newell Companies V. Kenney Mfg. Co.*, 864 F 2d 757, 768, 9 USPQ2d 1417, 1426 (Fed Cir. 1988) (Although at one time there was a long felt need for a do it yourself window shade material which was adjustable without the use of tools, a prior art product fulfilled the need by using a scored plastic material which could be torn.

With respect to argument C, the examiner respectfully traverses. The appellant states in paragraphs 10 and 18, "it took over two years for potential customers to appreciate the results/benefits they would see from a product that is substantially more

expensive” and “the claimed anti-chafe product formed of a fabric of Spectra® yarns has a slick characteristic” as support for the establishment of secondary consideration of unexpected results. The above statements are insufficient to establish unexpected results, because the appellant has not supplied any factual evidence that the prior art doesn’t contain the disclosed unexpected result. Specifically, factual evidence should compare the claimed invention to the prior art reference to display the expected results.

The MPEP instructs the examiner as follows:

TO BE OF PROBATIVE VALUE, ANY OBJECTIVE EVIDENCE SHOULD BE SUPPORTED BY ACTUAL PROOF

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) (“It is well settled that unexpected results must be established by factual evidence.” “[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant’s heat shrinkable articles with those of the closest prior art, we conclude that appellant’s assertions of unexpected results constitute mere argument.”). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991)

While the appellant has supplied data comparing the cost of Spectra® to Cordura®, there is no factual data on record comparing the characteristics such as abrasion resistance, tear resistance, and chemical resistance, of which the appellant is stating is a result of the claimed invention. Secondly, it is the opinion of the examiner

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that characteristics the appellant is implying as unexpected results are established by Holland, and that such claims by the appellant are unsupported as Holland, in a public document, US Patent Number 5,395,682, has stated all of the properties disclosed in the specification by the appellant, that the protective cover exhibits. Therefore, the declaration is insufficient to establish unexpected results.

With respect to argument D, the examiner respectfully traverses. The appellant cites in paragraph 5 of the declaration, the gross sales of a product, states the sales the claimed invention has been significant since the introduction of the product in 2002 (see paragraph 6 of the declaration), provides comparative data between the anti-chafe product with unsuccessful products made of Cordura® and ballistic nylon, and details the sales growth to the United States Navy and Coast Guard, to support what the appellant details as compelling evidence of commercial success. A declaration of gross sales alone, without evidence of the actual percentage of the current market is inadequate to provide support for commercial success. Specifically, the MPEP states:

IV. >< SALES FIGURES MUST BE ADEQUATELY DEFINED

Gross sales figures do not show commercial success absent evidence as to market share,

Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 226 USPQ 881 (Fed.

Cir. 1985), or as to the time period during which the product was sold, or as to what sales

would normally be expected in the market, Ex parte Standish, 10 USPQ2d 1454 (Bd.

Pat. App. & Inter. 1988).

Secondly, the courts have been consistent that the evidence presented to establish commercial success must be in commensurate with the scope of the claims.

Specifically, the MPEP states

I. >< EVIDENCE OF COMMERCIAL SUCCESS MUST BE
COMMENSURATE IN SCOPE WITH THE CLAIMS

Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. In re Tiffin, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate >in< scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. Joy Technologies Inc. v. Manbeck, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), aff 'd, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.).

An affidavit or declaration attributing commercial success to a product or process "constructed according to the disclosure and claims of [the] patent application" or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. Ex parte Standish, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

Specifically, the appellant has stated in the affidavit, that the company (JHRG) has spent less than 50,000 dollars on advertising, however for a company employing 35

people, 50,000 dollars would constitute a substantial amount of the operating budget and therefore without any comparison of factual evidence to compare, such as an overall operating budget, types of advertisement, the examiner cannot state that the commercial success was attributed to the claim invention. In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to appellant or assignee, or other business events extraneous to the merits of the claimed invention, etc. In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); In re Noznick, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

In light of the above comments, the examiner respectfully submit that there is not enough factual data to establish commercial success of the claimed invention and therefore doesn't exist a nexus between the claimed invention and commercial success.

Finally, in considering all of the factual evidence submitted, which includes the declarations submitted on May 27, 2005 and May 30, 2006, letters submitted for the companies cited above, and the arguments presented on the record with respect to non-obviousness, and evaluating the facts as a whole, and weighing them against the

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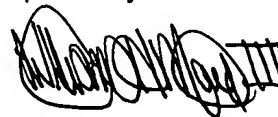
evidence supporting a prima facie case of obviousness, the examiner has come to the following conclusion. When all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



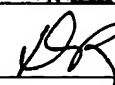
WHM III
August 28, 2006

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